

REMARKS

This Amendment is responsive to the Office action mailed December 14, 2005. Claims 54, 55, 57, 60-63 and 66-70 are pending in the application. Claims 54, 55, 57, 60-63 and 67-70 have been amended. No new matter is presented. Reconsideration is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 54, 55, 57, 60-63 and 66-70 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jayaraman (U.S. Patent No. 6,360,749) in view of Lau et al. (U.S. Patent No. 6,517,570). Applicant respectfully traverses. As a preliminary matter, the invention is broader than as described by the Examiner. For example, since independent claim 54 is an apparatus claim, statements of intended use have been given no weight by the Examiner, and therefore should not form a basis for rejection of the claim as well.

Claim 54 has been amended to now recite "a plurality of spring elements formed from a nitinol alloy and adapted to impart compressive force to a portion of the heart during diastole and systole." The "spring elements" and the "nitinol" alloy are fully disclosed and supported in the specification. For example, "spring elements" are disclosed at page 13, lines 11-16, and reference to nitinol is disclosed throughout the specification. Independent claim 54, as amended, does not depend on where the spring elements are attached to the heart, either endocardially or epicardially. In other words, the spring elements, formed from a nitinol alloy, can be attached anywhere on the heart, or in the heart, to "impart compressive force to a portion of the heart during diastole and systole." The Jayaraman reference fails to teach or even suggest any of the elements of claim 54. Jayaraman does not teach or suggest "a plurality of spring elements." The Jayaraman reference fails to teach or suggest spring elements "adapted to impart compressive force to a portion of the heart during diastole and systole." Finally,

Jayaraman fails to teach or suggest "the spring elements being configured to be delivered minimally invasively." The Jayaraman patent is completely devoid of any teaching of how to deliver the band 20 in a minimally invasive manner. While Jayaraman, at column 12, lines 52-60, teaches compressing the band into a catheter, there is no teaching or suggestion as to how the band is deployed and expanded in order to be placed around the outer surface of the heart.

Further, disclosure of spring elements formed from a nitinol alloy are fully supported by the previously submitted Lau, Hartigan and Ogi notebooks. For example, at pages 50 and 57 of the Lau notebook, "zig zag coil springs" and "spring members" were disclosed to impart a compressive force to a portion of the heart during diastole and systole. Similarly, at page 1 of the Ogi notebook, "strips of springs" formed of "nitinol" strips, were used to impart a compressive force to a portion of the heart during diastole and systole. These disclosures were made prior to October 8, 1998, the filing date of the Jayaraman '749 patent. Also disclosed in the previously submitted lab notebooks of Lau, Ogi and Hartigan are alternative embodiments of "spring elements" that were developed and subsequently reduced to practice. Thus, it is requested that the Declarations filed under 37 C.F.R. § 1.131 in the prior Amendment be considered and applied here to antedate the Jayaraman patent.

It is Applicant's position that claim 54, as amended, is patentably distinguishable over the Jayaraman reference, and also that the invention of claim 54 antedates the Jayaraman reference. Further, since all of the limitations of claim 54 are found in the dependent claims, the Jayaraman reference is removed or antedated with respect to those claims as well. Accordingly, the rejection of all of the claims under 35 U.S.C. § 103(a) should be withdrawn since the invention has been proven to antedate the primary reference to Jayaraman and the claims are patentably distinguishable as well.

As a final matter, with respect to claims 66-67, Applicant strenuously objects to combining the Lau et al. '570 disclosure of "nitinol" for use in the bands disclosed in the

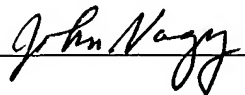
Jayaraman patent. As the Examiner is aware from the personal interview of October 6, 2005, Mr. Lau is a prolific inventor having more than fifty U.S. issued patents on which he is the inventor or co-inventor. A substantial number of those patents relate to stent technology. Mr. Lau can be considered a person having ordinary skill in the art as of 1998 with respect to stent technology. If it were obvious to combine stent technology with the bands disclosed in the Jayaraman patent, and to make those bands out of nitinol, Mr. Lau is the person who would have done it since he had the most experience. However, as disclosed in the notebook pages submitted in the previous amendment, Mr. Lau, and his co-inventor and technician, all of whom had stent technology experience, worked for many months in developing "spring elements" formed of various materials, including stainless steel and nitinol. The combination of spring elements made from nitinol was not obvious to them as shown in the lab notebook pages. Thus, the failure of Jayaraman to disclose nitinol for use with his bands, and the lack of any motivation by a person having skill in the art to combine Jayaraman and Lau et al., two unrelated technologies for treating two different medical conditions, warrants withdrawing the rejection of claims 66-67 under § 103. It is pure speculation on the Examiner's part that a person skilled in the art would ever consider the use of nitinol with the Jayaraman bands. Jayaraman simply states that the bands can be made from stent graft materials, of which there are a substantial number of different materials used. Assuming *arguendo* that a person having skill in the art had all of the stent materials available from which to choose in order to make spring elements, there would be undue experimentation required to determine which materials were best suited to form the claimed spring elements and have them function in the claimed manner.

Conclusion

Claims 54, 55, 57, 60-63, and 66-70 remain pending in the application. Reconsideration is respectfully requested. If a telephone interview would facilitate prosecution of the application, the undersigned can be reached at (310) 824-5555.

Respectfully submitted,

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